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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,706	06/08/2005	Koki Ikeda	2005_0791A	8683
513	7590	10/16/2006	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			BOYKIN, TERRESSA M	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			1711	

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/534,706

Applicant(s)

IKEDA ET AL.

Examiner

Terressa M. Boykin

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

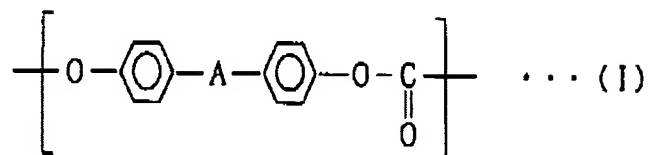
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1- 9, 17-26 are rejected under 35 U.S.C. 102(b, or e) as being anticipated by EP 0591962 see abstract, see pages 1-13 and claim 1; or JP 06006383 see translation as attached to the JP patent copy herein.

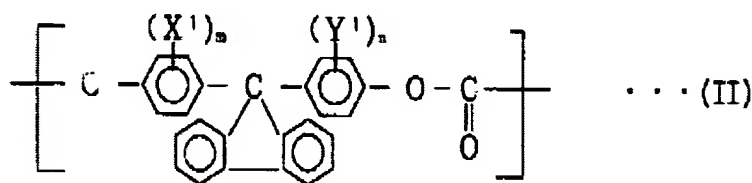
EP 0591962 discloses is a polycarbonate copolymer excellent in heat resistance and impact resistance, and a suitable process for producing said copolymer. The reference is a polycarbonate copolymer which comprises a carbonate structural

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unit A represented by the general formula (I):



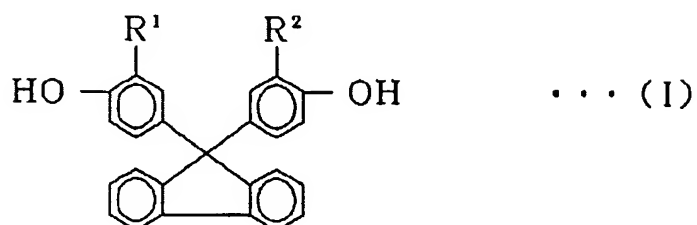
and a carbonate structural unit B represented by the general formula (II):



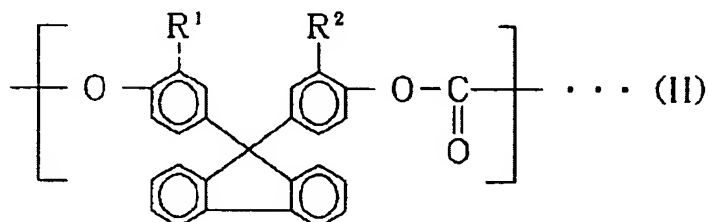
and wherein the proportion of the carbonate structural unit B and the viscosity average molecular weight are specified. The polycarbonate copolymer is suitably used for optical parts, mechanical parts, electric and electronic parts, and automotive parts. The above-mentioned copolymer can be efficiently produced by interfacial polycondensation of an aromatic diol (structural unit A) and a fluorene derivative (structural unit B), with phosgene or a phosgene derivative in the presence of methylene chloride as an inert organic solvent, said fluorene derivative being in the form of aqueous solution in potassium hydroxide.

JP 06006383 a copolymer having excellent thermal stability of molding free from problems such as corrosion of mold during molding by using an aqueous solution of KOH of a bis(hydroxyphenyl)fluorene derivative and a specific inert organic solvent.

In subjecting an aromatic diol containing a 9,9-bis(4- hydroxyphenyl)fluorene derivative of formula I



are H or 1-8C organic group) and phosgene (derivative) to interfacial polycondensation, an aqueous solution of KOH of the compound of the formula is used and the reaction is carried out in the presence of methylene chloride to give the objective copolymer having a unit of formula II as shown below.



and the content of residual chlorine-based solvent of 200ppm or smaller. For example, an aqueous solution of KOH containing the compound of the formula and another aromatic diol is allowed to react with phosgene in the presence of methylene chloride or an aqueous KOH solution of the compound of the formula is reacted with phosgene and the formed oligomer is reacted with another aromatic diol.

The references above discloses a polycarbonate copolymer prepared from the same components as claimed by applicants. With regard to claims 6-16, any

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properties or characteristics inherent in the prior art, e.g. b value, Yellow Index (YI) and/or sulfur or chlorine content, although unobserved, unmentioned or detected by the reference, would still anticipate the claimed invention. Note In re Swinehart, 169 inherently possessed by things in the prior art, does not cause claim drawn to those things ". Since the disclosed amounts, i.e. mole%, are expressed differently, they nevertheless appear to overlap those claimed and thus are not distinguishable over the prior art. Each of the reference employs the composition as a mold which may be in the form of between the reference and that which is claimed by applicant(s). The preparation of particles from the composition is of no extraordinary unanticipatory thought for one in the art of preparing such composition since the resulting product may often be selected as such, i.e. particles, depending upon the intended use. Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1- 8, 9 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0591962 see abstract, see pages 1-13 and claim 1; or JP 0600638? see abstract and translation as attached to the JP patent copy herein.

With regard to claims 1-8, each of the references discloses a composition prepared from the same components as claimed by applicants except for the particular parameters as claimed, b value, yellow Index (YI) and/or sulfur or chlorine content, as disclosed herein.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to manipulate the parameters of the composition as deemed necessary since characteristics are well-known and sought in the art.

With regard to claim 9, the reference discloses a composition prepared from the same components as claimed by applicants except for being carried out in the absence of oxygen disclosed herein. However, the deleterious effect of oxidation on fragile or unstable intermediate product or final products is well-known and thus it is often suitable to conduct many reactions in a vacuum or under an inert atmosphere.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an atmosphere void of O₂ since such is common practice in the art to avoid oxidation or degradation of a fragile or unstable product or intermediate product.

With regard to claims 10-16, the reference discloses a composition prepared from the same components as claimed by applicants except for use of an ultraviolet absorber disclosed herein. However, it is exhaustively well-known in the art to employ an UV absorber to compositions in order have a clearer (less yellow) resulting product.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a UV absorber to avoid discoloration since it is well documented in the polymer art that UV absorber avoid discoloration of polymer plastics.

Consequently, the claimed invention cannot be deemed as unobvious and accordingly is unpatentable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terressa M. Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday-Thursday 10-5:30 Friday (work at home).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applicatic..s may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Terressa M. Boykin
Primary Examiner
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